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31780	7590	09/11/2009	EXAMINER	
ERIC ROBINSON			POTTER, ROY KARL	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/045,902
Filing Date: January 16, 2002
Appellant(s): YAMAZAKI, SHUNPEI

Eric J. Robinson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/26/07 appealing from the Office action mailed 1/4/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 – 35 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath/declaration is set forth in the discussion above in this Office action.

The reissue oath/declaration filed with this application is defective because none of the errors which are relied upon to support the reissued application are errors upon which a reissue can be properly based. The alleged errors recited in the oath/declaration do not recite an error in the specification, drawings or claims which cause the original patent to be defective. The alleged errors include:

- 1) That the Petition to Withdraw a Terminal Disclaimer: filed during the prosecution of the original patent application was not properly handled;

- 2) That the original patent application was not withdrawn from issue before the payment of the issue fee;
- 3) That the original patent application was not withdrawn from issue after the payment of the issue fee;
- 4) That the issuance of the original patent was not deferred until the Petition to Withdraw the Terminal Disclaimer was considered and acted upon.

These are not errors which can be properly corrected by a reissue application.

(10) Response to Argument

The reissue of the present Appeal is sought based on the alleged errors of the failure of the Patent and Trademark Office to properly act on the Petition to Withdraw a Terminal Disclaimer filed under 37 CFR 1.182 or withdrawing the application from issuance under 37 CFR 1.313 either before or after the payment of an issue fee and that this error resulted in the patentee claiming less than the patentee had a right to claim in regards to the term of the patent that issued.

The alleged error would have been avoided if the Petition to Withdraw a Terminal Disclaimer had been approved by the Patent Office prior to the patent issuing, or if the patent has been withdrawn from issue before or after the payment of the issue fee, until the Petition to Withdraw a Terminal Disclaimer had been acted upon. The question for Appeal is whether a reissue application is the proper method for correcting an error resulting from a non considered Petition to Withdraw a Terminal Disclaimer

In the Durckheimer decision, cited by the Appellant, the claims were secured by a Terminal Disclaimer and those claims were subsequently canceled before the Patent issued. A reading of the Durckheimer et al. decision reveals on page 21 of the decision that there was "an unique set of facts and circumstances wherein the claims which were secured by the filing of the terminal disclaimer were cancelled before the patent was granted." The Terminal Disclaimer secured none of the claims that were issued in the patent. This unique set of facts appears to have figured prominently in the decision that was reached by the Board. In the present Reissue under appeal, the Terminal Disclaimer was not rendered moot by the cancellation of claims as in Durckheimer.

According to the MPEP, remedy by reissue (35 U.S.C. 251) is not available to correct all errors and is not available to withdraw or otherwise nullify the effect of a Terminal Disclaimer recorded in an issued patent. As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner — e.g., intervening rights in the case of a reissue patent. See, e.g., *Altoona Publix Theatres v. American Tri-ErgonCorp.*, 294 U.S.477,24 USPQ 308 (1935).

The Appellant's alleged errors do not appear to be errors that can be properly corrected through reissue.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

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